



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,480	07/25/2000	Andrew Francis Kirby	470044.404	9654

7590

06/24/2003

Seed Intellectual Property Law Group
Suite 6300
701 Fifth Avenue
Seattle, WA 98104-7092

EXAMINER

RAJGURU, UMAKANT K

ART UNIT

PAPER NUMBER

1711

18

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on Mar 17, 2003 (papers 15 & 16)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-65 is/are pending in the application.
- Of the above claim(s) 38 and 58-65 is/are withdrawn from consideration.
- ☒ Claim(s) 1 and 2 is/are allowed.
- ☒ Claim(s) 9-57 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 17
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1711

1. An RCE (paper 15), a response (paper 16) and an IDS (paper 17) have been filed all on March 17, 2003.
2. Claims 1, 2 and 9-57 are being examined.
3. Rejection of claims 15, 16, 24-27, 29, 32, 46-49, 51, 54 and 55 under USC 112, second paragraph (see items 4 and 7 of prior office action, paper 13) is now withdrawn.
4. Objection to the amendment (paper 9) under 35 USC 132 (see item 9 of same office action, viz paper 13) is also withdrawn.
5. Rejection of claims 9-57 under 35 USC 103(a) (see item 5 of prior office action, paper 13) is now withdrawn.
6. However claims 1, 9, 15, 16, 18, 24-26, 33, 37-41, 46-48, 55 and 57 stand rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Introduction of – finely divided solid – and the water soluble – in claims 1, 9 etc. has been shown by applicants to have support from the specification; but (a) changing “cyclopentene” to – cyclopentane – in claim 1, (b) introduction of a proviso at end of step (i) in a claim 9, (c) introduction of – or $\text{CH}_2\text{CO}_2\text{H}$ – etc. in claim 15 ^{and} (d) similar other changes in remaining claims are presented without pointing the support thereof.

This is the only outstanding rejection in this case.

Art Unit: 1711

It should be noted here that, in case, claims 9, 18 and 37-41 be amended later to obviate their rejection under 35 USC 112, first paragraph, the withdrawn 103(a) rejection will be reinstated.

7. Applicants argue that the said amendment does not introduce new matter.

These arguments are not persuasive. Applicants are not excluding any species from a genus by that amendment. The amendment is intended to obviate the rejection based on prior art. That amendment does introduce new matter.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

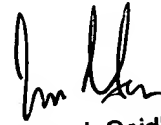
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Art Unit: 1711



U. K. Rajguru/mn
June 19, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700